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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/014,557	12/14/2001	Kouichi Oda	110923	6031

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EXAMINER
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REIFSNYDER, DAVID A

ART UNIT	PAPER NUMBER
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1723

DATE MAILED: 09/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/014,557

Applicant(s)

ODA ET AL.

Examiner

David A Reifsnyder

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 April 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All   b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3 and 4.                      6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Specification***

The specification is objected to because the Incorporation by Reference of Japanese Patent Application No. 2000-387906 is improper. Japanese Patent Application No. 2000-387906 is a Priority Document which the applicant has claimed Priority benefits under title *35 U.S. Code § 119* in his Declaration. To correct this problem, the Incorporation by Reference section of the specification should be deleted.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1 and 15; the recitation in both of those claims of "a plurality of bag-like members formed in a container shape having an opening and disposed with intervals therebetween in the filter portion" is vague and indefinite as to whether each bag-like member has an opening and each bag-like member is shaped like a container or if somehow the plurality of bag-like member has a single opening and the plurality of bag-like members is shaped like a container. If the plurality of bag-like member has a

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single opening and the plurality of bag-like members is shaped like a container, then the claims are so vague and indefinite as to be impossible to understand. From the specification it is believed that each bag-like member is shaped like a container and each bag-like member has an opening.

Regarding claim 11; the recitation of "with the flat plate member supporting a periphery of the opening of the bag-like members" can not be understood because before that recitation it was claimed that each bag-like member has an opening, while the recitation of "supporting a periphery of the opening of the bag-like members" implies that the bag-like members somehow share a single opening. Furthermore, since the bag-like members sharing a single opening was never claimed the recitation of "the opening" lacks antecedent basis.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by DE 27 36 433 A.

Regarding claims 1-20; DE 27 36 433 A discloses a filter and method of manufacturing that filter having a filter portion with a plurality of bag-like members

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disposed with intervals therebetween in the filter portion, each bag-like member formed in a polygonal container shape and having an opening with a periphery; and a supporting member which supports the periphery of each bag-like member and connects each of the bag-like members, the method of manufacturing comprising: preparing a forming die made of a permeable meshed metal and provided with a forming surface which is formed in a shaped corresponding to that of one side of the filter; and laminating semi-molten fibers over the forming surface of the forming die. (see the Abstracted Publication and Figs. 1-4)

Claims 1, 3, 5-8, 10,11, 13 and 15-20 are rejected under 35 U.S.C. 102(b) as being anticipated by JP A 08-38834.

Regarding claims 1, 3, 5-8, 10,11, 13 and 15-20; JP A 08-38834 discloses a filter and method of manufacturing that filter having a filter portion with a plurality of bag-like members disposed with intervals therebetween in the filter portion, each bag-like member formed in a container shape and having an opening with a periphery; and a supporting member which supports the periphery of each bag-like member and connects each of the bag-like members, the method of manufacturing comprising: preparing a forming die made of a permeable meshed metal and provided with a forming surface which is formed in a shaped corresponding to that of one side of the filter; and laminating semi-molten fibers over the forming surface of the forming die. (see Fig. 6 and the claims)

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 2 ,4, 9, 12, and 14 rejected under 35 U.S.C. 103(a) as being unpatentable over JP A 08-38834.

Regarding claims 2, 4, 9, 12 and 14; JP A 08-38834 discloses a filter and method of manufacturing that filter as discussed above but fails to disclose the instantly claimed shapes of the bag-like members. It is considered that it would have been obvious to one having ordinary skill in the art at the time of the invention, that JP A 08-38834's bag-like members be any desired shape, because a change in shape is generally recognized as being within the level of ordinary skill in the art. **In re Dailey and Eilers 149 USPQ 47 (CCPA 1966).**

### ***Prior Art***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Takagaki et al. who discloses a filter medium and production method thereof.

Herding et al. who discloses a filter unit for insertion into a filter housing.

Sugie et al. who discloses a filter element for an air cleaner.

Nakayama et al. who discloses an automobile filter element.

Timmons et al. who discloses a method of making a nonwoven web with improved barrier properties.


### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David A Reifsnyder whose telephone number is (703) 308-0456. The examiner can normally be reached on M-F 9:00 AM to 5:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda M Walker can be reached on (703) 308-0457. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-3601.

  
David A Reifsnyder  
Primary Examiner  
Art Unit 1723

DAR